APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,434	12/31/2003	Stephen Lawrence	24207-10095	9581

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GOOGLE / FENWICK
SILICON VALLEY CENTER
801 CALIFORNIA ST.
MOUNTAIN VIEW, CA 94041

EXAMINER
KIM, PAUL

ART UNIT	PAPER NUMBER
2161	

MAIL DATE	DELIVERY MODE
06/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	**Applicant(s)**
Office Action Summary	10/749,434	LAWRENCE ET AL.
	Examiner	**Art Unit**	
	Paul Kim	2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>30 March 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>25,26,54,55 and 62-103</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>25,26,54,55 and 62-103</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/18/04, 6/9/05</u>.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

U.S. Patent and Trademark Office

PTOL-326 (Rev. 08-06)   Office Action Summary   Part of Paper No./Mail Date 20070604

DETAILED ACTION

1.   This Office action is responsive to the following communication: Amendment filed on 30 March

2007.

2.   Claims 25-26, 54-55, 62-82 and 83-103 are pending and present for examination. Claims 25 and

54 are in independent form.

Election/Restrictions

3.   Applicant's election with traverse of Group II in the reply filed on 30 March 2007 is

acknowledged. The traversal is on the ground(s) that a search an examination of all claims in the

application can be made without serious burden. This is not found persuasive because the groups are

directed to different embodiments of the claimed invention..

The requirement is still deemed proper and is therefore made FINAL.

Response to Amendment

4.   Claims 25-26 and 54-55 have been amended.

5.   Claims 62-103 have been added.

6.   No claims have been cancelled.

Information Disclosure Statement

7.   The information disclosure statements (IDS) submitted on 18 October 2004 and 09 June 2005

are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement

is being considered by the examiner.

Claim Rejections - 35 USC § 101

8.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9.   **Claims 25-26, 54-55, 62-82 and 83-103** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed toward a method of gathering client behavior data and applying said behavior data in the ranking of relevant articles, and are non-statutory because they fail to accomplish a "useful, concrete and tangible result." See State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. MPEP 2106. "The claimed invention as a whole must accomplish a practical application. That is, it must produce a 'useful, concrete and <u>tangible</u> result' " (emphasis added). While the claims describe said storing of client behavior data and the arranging of the relevant articles based on said behavior data, the claims fail to recite the necessary steps, (e.g. the returning the arranged articles to a user on a display) such that a "useful, concrete, and tangible result" would be provided.

Claim Rejections - 35 USC § 102

10.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11.   **Claims 25-26, 54-55, 62-63, 71, 80, 83-84, 92 and 101** are rejected under 35 U.S.C. 102(b) as being anticipated by Uchiyama (USPGPUB No. 2002/0065802), filed on 30 May 2001, and published on 30 May, 2002.

12. **As per independent claims 25 and 54,** Uchiyama teaches:

A method comprising:

> determining client-side behavior data associated with an article {See Uchiyama, [0058], wherein this reads over "the program code . . . may monitor the activity of the browser software so as to collect information concerning that user's browsing behavior, habits, preferences, biases"};

> providing the client-side behavior data associated with the article to a ranking processor {See Uchiyama, [0059], wherein this reads over "[t]he program code 140 then, may transmit collected data to the central server 120 for recordation, categorization, and aggregation with data collected from other users"};

> calculating a predetermined client behavior score based at least in part on the client behavior data associated with the article {See Uchiyama, [0092], wherein this reads over "[t]he system, therefore, may provide customized search results by utilizing user profile information collected for each respective individual and comparing that user profile data with the statistical data concerning a given potential search result. Each prospective search result may be weighted or ranked, for example, at least partially as a function of the comparison with the user profile data"}; and

> storing the predetermined client behavior score in a data store, wherein the data store associates the predetermined client behavior score with the article {See Uchiyama, [0062], wherein this reads over "[a]s a user visits various sites during browsing session, relevant information is collected at the client side and transmitted to the central server 120, where it may be stored in appropriate database records associated with the user, the URL or site itself"}.

13. **As per dependent claims 26 and 55,** Uchiyama teaches:

The method of claim 25 further comprising:

> receiving a search query {See Uchiyama, [0058], wherein this reads over "[k]eywords or query terms which the user submitted prior to navigating to the Web site"};

> determining a relevant article associated with the search query {See Uchiyama, [0091], wherein this reads over "[b]y compiling data from registered users in the database within the central server 520, search results for any given query will improve over time"};

> receiving from the data store a predetermined client behavior score associated with the relevant article {See Uchiyama, [0092], wherein this reads over "provide customized search results by utilizing user profile information collected for each respective individual"}; and

> arranging the relevant article based at least in part on the predetermined client behavior score associated with the relevant article {See Uchiyama, [0092], wherein this reads over "[e]ach prospective search result may be weighted or ranked, for example, at least partially as a function of the comparison with the user profile data"}.

14. **As per dependent claims 62 and 83,** Uchiyama teaches:

The method of claim 26, wherein the search query is an explicit search query {See Uchiyama, [0058], wherein this reads over "[k]eywords or query terms which the user submitted prior to navigating to the Web site"}.

15.   **As per dependent claims 63 and 84,** Uchiyama teaches:

The method of claim 26, wherein the search query is an implicit search query {See
Uchiyama, [0058], wherein this reads over "[k]eywords or query terms which the user submitted prior to
navigating to the Web site"}.

16.   **As per dependent claims 71 and 92,** Uchiyama teaches:

The method of claim 25, wherein the client-side behavior data associated with the
relevant article comprises frequency of article access data {See Uchiyama, [0117], wherein
this reads over "organize search results according to the most popular, or most frequently visited URLs"}.

17.   **As per dependent claims 80 and 101,** Uchiyama teaches:

The method of claim 25, further comprising determining a combined score based at least
in part on client-side behavior data for multiple users {See Uchiyama, [0014], wherein this
reads over "operate to gather and to collect human knowledge by monitoring users' activities on the client
or browser side"; [0086], wherein this reads over "compare the respective data store in two users'
respective profiles and subsequently compute a relative measure of the compatibility"}.

Claim Rejections - 35 USC § 103

18.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art
> are such that the subject matter as a whole would have been obvious at the time the invention was made to a
> person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
> negatived by the manner in which the invention was made.

19.   **Claims 64-70, 72-79, 81-82, 85-91, 93-100, and 102-103** are rejected under 35 U.S.C.

103(a) as being unpatentable over Uchiyama, in view of Official Notice.

20.   **As per dependent claims 64 and 85,** the Examiner takes Official Notice that it would have

been obvious and widely-known to those of ordinary skill in the art that the client-side behavior data

associated with the relevant article could comprise scrolling activity data (i.e. whether the user scrolled

down the relevant article to view more of the content).

21.   **As per dependent claims 65 and 86,** the Examiner takes Official Notice that it would have

been obvious and widely-known to those of ordinary skill in the art that the client-side behavior data

associated with the relevant article could comprise printing data (i.e. whether the user printed out the

relevant article).

22.   **As per dependent claims 66 and 87,** the Examiner takes Official Notice that it would have been obvious and widely-known to those of ordinary skill in the art that the client-side behavior data associated with the relevant article could comprise book marking data (i.e. whether the user bookmarked an article).

23.   **As per dependent claims 67 and 88,** the Examiner takes Official Notice that it would have been obvious and widely-known to those of ordinary skill in the art that the client-side behavior data associated with the relevant article could comprise use of computer program application data (i.e. the type of browser utilized by the user).

24.   **As per dependent claims 68, 70, 89, and 91,** the Examiner takes Official Notice that it would have been obvious and widely-known to those of ordinary skill in the art that the use of computer program application data is used in connection with additional client-side, behavior data (i.e. data regarding the type of browser utilized may be combined with other featured behavior data to build a user profile).

25.   **As per dependent claims 69 and 90,** the Examiner takes Official Notice that it would have been obvious and widely-known to those of ordinary skill in the art that the client-side behavior data associated with the relevant article could comprise idleness data.

26.   **As per dependent claims 72 and 93,** the Examiner takes Official Notice that it would have been obvious and widely-known to those of ordinary skill in the art that the client-side behavior data associated with the relevant article could comprise time of access data (i.e. the time the user accessed the relevant article).

27.   **As per dependent claims 73 and 94,** the Examiner takes Official Notice that it would have been obvious and widely-known to those of ordinary skill in the art that the client-side behavior data associated with the relevant article could comprise time of access relative to the access of other associated articles data (i.e. the proximity in time of accessed articles by the user).

28.   **As per dependent claims74 and 95,** the Examiner takes Official Notice that it would have been obvious and widely-known to those of ordinary skill in the art that the client-side behavior data

associated with the relevant article could comprise forwarding data (i.e. whether the user forwarded the data to another user or entity).

29.   **As per dependent claims 75 and 96,** the Examiner takes Official Notice that it would have been obvious and widely-known to those of ordinary skill in the art that the client-side behavior data associated with the relevant article could comprise copying data (i.e. whether the user copies portions of data from the relevant article).

30.   **As per dependent claims 76 and 97,** the Examiner takes Official Notice that it would have been obvious and widely-known to those of ordinary skill in the art that the client-side behavior data associated with the relevant article could comprise replying data (i.e. whether the user provided a response to the relevant article via voting or commenting).

31.   **As per dependent claims 77 and 98,** the Examiner takes Official Notice that it would have been obvious and widely-known to those of ordinary skill in the art that the client-side behavior data associated with the relevant article could comprise mouse movement data (i.e. the regions of the relevant article or application which the user may have navigated the mouse).

32.   **As per dependent claims 78 and 99,** the Examiner takes Official Notice that it would have been obvious and widely-known to those of ordinary skill in the art that the client-side behavior data associated with the relevant article could comprise user interactions with a separate article data.

33.   **As per dependent claims 79 and 100,** the Examiner takes Official Notice that it would have been obvious and widely-known to those of ordinary skill in the art that the client-side behavior data associated with the relevant article could comprise location data (i.e. the IP address or geographical region wherein the user is located).

34.   **As per dependent claims 81 and 102,** the Examiner takes Official Notice that it would have been obvious and widely-known to those of ordinary skill in the art to combine a plurality of types od client-side behavior data to determine and provide a combined score for use in ranking the relevant articles according to said client-side behavior data.

35.   **As per dependent claims 82 and 103,** the Examiner takes Official Notice that it would have been obvious and widely-known to those of ordinary skill in the art that different weights for different types of behavior data would be used in the computation of the score such that certain behavior data would be accorded more weight than others.
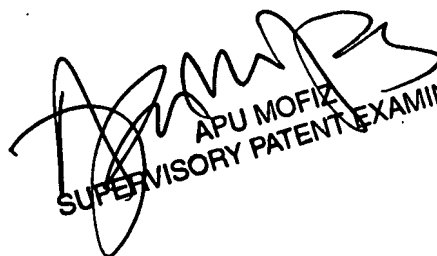
Conclusion

36.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Kim whose telephone number is (571) 272-2737. The examiner can normally be reached on M-F, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on (571) 272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Paul Kim
Patent Examiner, Art Unit 2161
TECH Center 2100